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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,016	01/12/2001	Russell E. Parks	FIS9-2000-0282	1797

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EXAMINER

OUELLETTE, JONATHAN P

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 04/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 09/759,016	Applicant(s) PARKS ET AL.	
Examiner Jonathan Ouellette	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 12 February 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-7 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-7 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) Paper No(s). <u>7</u> .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Response to Amendment

1. The examiner acknowledges receipt of formal drawings for application 09/759,016 submitted on 2/12/03.

Claim Rejections - 35 USC § 101 and 35 USC § 112

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. An invention, which is eligible for patenting under 35 U.S.C. § 101, is in the “useful arts” when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a “useful, concrete and tangible result.” The test for practical application as applied by the examiner involves the determination of the following factors:

- (a) “Useful” – The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the

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claimed invention to determine whether the asserted utility is accomplished.

Applying utility case law the examiner will note that:

- i. the utility need not be expressly recited in the claims, rather it may be inferred.
- ii. If the utility is not asserted in the written description, then it must be well established.

(b) "Tangible" – Applying *In re Warmerdan*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed.

Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. § 101. In *Warmerdam* the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

(c) "Concrete" – Another consideration is whether the invention produces a "concrete" result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C. § 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

5. Claims 1-7 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. Specifically:

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6. In Claims 1-7, the ambiguities cited would make it impossible for the process to be repeatable or “concrete.” In other words, different users would come up with different responses.
7. As per Claims 1-7, it appears that the (Web-based, computer system running) Skills Matching Application (SMA) is attempting to sell a matching service for professionals, whereas a match is dependent on independent criteria provided by the client. These independent criteria could contain a vast amount of different setting combinations – which would include different settings for each of the following: the technical skills requested by the client and the quantity/quality of candidates (resumes) populating the database. Thus, this Skills Matching Application is not repeatable and would appear to be an attempt to patent an abstract idea not a “concrete” process.
8. Claims 1-7 also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention lacks a patentable utility, for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Puram et al.

(US 6,289,340 B1).

11. As per independent Claims 1, 4, and 5, Puram discloses a (Web-based, computer

system running) Skills Matching Application (SMA) which allows a user to communicate requirements to technical service suppliers in a way that significantly reduces the process time and improves the accuracy of requests sent to suppliers

comprising the steps of: means for accessing the SMA from a Requisition/Catalog

(REQ/CAT) application; means for prompting a user through a series of screens to

enter a Statement of Work (SOW) and complete a skills detail checklist for each of

the technical skills requested; means for submitting the request to contracted

suppliers by e-mail notification notifying the supplier that a new request has been

entered into the SMA application for them to review and submit a candidate against;

means for receiving from a supplier a candidate or candidates with appended resumes

as appropriate; and means for displaying for the user the supplier responses and

associated resumes (Abstract, Figs.1a-11b, C1 L17-43, C2 L28-67, C3 L1-47, C8

L30-34, C8 L61-67, C9 L1-10, C9L44-61, C10, L1-L9).

12. As per Claims 2 and 6, Puram discloses wherein the SMA and REQ/CAT

applications are Web-based and an SMA Web site is provided for suppliers to access

to view request details and submit a candidate or candidates (Abstract, Figs.1a-11b,

C1 L17-43, C2 L28-67, C3 L1-47, C8 L30-34, C9L44-61, C10, L1-L9).

13. As per Claims 3 and 7, Puram discloses responding to a user's selection of a candidate or candidates by invoking an approval and procurement process (Abstract, Figs.1a-11b, C1 L17-43, C2 L28-67, C3 L1-47, C8 L30-34, C8 L61-67, C9 L1-10, C9L44-61, C10, L1-L9).

Response to Arguments

14. The Examiner thanks the inventor Mr. Russell Parks for taking the time on 3/26/2003 (telephonic interview) to further explain what he believed was the novel concept behind his invention. As explained in the attached interview summary, Examiner Ouellette, Mr. Parks, and Mr. Whitham discussed possible options for amending the claims to more clearly define them over the prior art – including information regarding the detailed process in which the Skills Matching Application is populated and correlated with specific (pre-negotiated) contract suppliers.

15. After further review of the specification, there is no indication of descriptive material, which would allow the applicant to incorporate the detailed process in which the Skills Matching Application is populated and correlated with specific (pre-negotiated) contract suppliers, without adding new material.

16. Therefore, applicant's arguments filed 1/28/03 and 3/31/2003 have been fully considered but they are not persuasive.

17. The applicant has made the declaration that the system has utility, due to the commercial success the claimed invention has proven since filed. The applicant also makes the declaration that "since different individuals have different skill sets and

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different requester have different skill need, one would expect different users to come up with different responses. Moreover, this should not be taken as an indication that the process ~~is~~ not repeatable or concrete.”

18. As stated above in the 35 U.S.C. 101 rejection - an invention, which is eligible for patenting under 35 U.S.C. § 101, is in the “useful arts” when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. So while the declaration by Mr. Parks may prove the system has tangible and useful results, the system does not produce a concrete result, and therefore is unpatentable.

19. The system does include different skill sets and different requesters who have different skill needs, but, these are controlled through a template format and do not affect the repeatability of the system. The system further sends an email to a supplier who looks at the SMA and manually matches an application to the skills template to the best of their ability. Without any form of automation incorporated in this step of the process, there is no way to ensure concreteness or repeatability in the system.

20. The applicant also makes the argument that the prior art of Puram et al. is simply a “Monster Board,” and does not contain the functionality of Skills Matching Application described in the independent claims – to include:

- a. means for inputting skills requirements for a potential employee
- b. means for submitting the request to a contract supplier
- c. means for the contract supplier to manually matches resumes to the skills template entries.

- d. means for the supplier to send potential candidates to the requestor.

21. As described in the 102(e) rejection above, Puram discloses each and everyone one of these elements:

- a. means for inputting skills requirements for a potential employee (Fig.2, C2 L44-50, C3 L50-58)
- b. means for submitting the request to a contract supplier through e-mail (server through the Internet) (C2 L49-50, C2 L55-58, C3 L25-30)
- c. means for the contract supplier to manually matches resumes to the skills template entries. (C3 L35-39)
- d. means for the supplier to send potential candidates to the requestor (C7 L4-27, C8 L30-34).

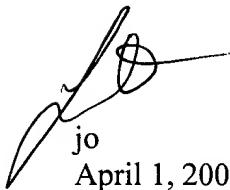
Conclusion

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (703) 605-0662. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.

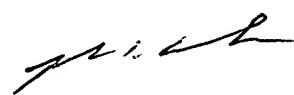
23. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-3597 for After Final communications.

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24. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.



jo
April 1, 2003



JOHN G. WEISS
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